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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,181	08/21/2003	Hiroshi Satomi	03500.014419.1	7320
5514 7590 10/12/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER DANNEMAN, PAUL	
			ART UNIT 3627	PAPER NUMBER
			MAIL DATE 10/12/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/645,181

Applicant(s)

SATOMI ET AL.

Examiner

Paul Danneman

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2003 + preliminary amendment received 5/13/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 385-417 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 385-417 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/548,973.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 26 August 2003.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**Status of the Claims**

- 19/7/07
1. This action is in response to the application filed on 26 August 2003.
  2. Claims 1 through 384 have been cancelled.
  3. Claims 385- 417 have been examined.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claims 385-417** are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly et al., US 5,740,549 henceforth know as Reilly.

7. **Examiner's note:** Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual

Art Unit: 3627

claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the **entire** reference as potentially teaching all or part of the claimed invention, as well as the content of the passage as taught by the prior art or disclosed by the Examiner.

**Claims 385, 393, and 401:**

With regard to the limitations:

- ***Memory stored instructions executed by a computer processor.***
- ***Reading the amount charged for user-selected information.***
- ***Reading the amount credited for incorporating automatically generated information.***
- ***Determining the total charge by adding the charged and credited amounts and displaying on a display.***

Reilly, in at least Figure 1, and Column 1 lines 1-10 discloses a computer based information distribution system for distributing to a set of subscribers' information matching each subscriber's interests as well as advertising. Reilly does not specifically disclose how revenues are generated. However, Reilly in at least Column 1 lines 13-15 discloses the use of advertising revenue to pay for information dissemination in domains such as television and radio and still in at least Column 1, lines 35-36 further discloses the used of mixing advertisements with information dissemination in newspapers and magazines to reduce the cost of the publication. Reilly, in at least Column 2, lines 24-26 and Figure 10 still further discloses an invention that mixes advertising and information content dissemination to subscribers in a manner unlike the previous examples. Therefore, it would be obvious, at the time of the invention, to a person of ordinary skill in the art to conclude that Reilly's invention is functionally equivalent to applicant's invention.

**Claims 386, 394, 402:**

With regard to the limitation:

- ***User selected information is output to the user.***

Reilly, in at least Column 2, lines 42-46 discloses categorizing news stories and advertisements and thereby providing a "targeted" audience for advertisers. Reilly, in at least Column 2, lines 47-52 and Figure 5 further discloses that the subscriber sets up a profile indicating categories and subcategories of topics that are of interest. Therefore, it would be obvious, at the time of the invention, to a person of ordinary skill in the art to determine that Reilly's invention provides a subscriber with content of interest in a manner similar to applicant's invention.

**Claims 387-391, 395-399, 403-407, 410, 413, and 416:**

With regard to the limitations:

- ***Determining the cost of user's selected information less the cost of advertising provided to user and equating that to a subsequent printing cost.***

Reilly does not disclose how a subscriber is charged for the content they have selected. Reilly, in at least Column 2, lines 42-46 discloses categorizing news stories and advertisements and thereby providing a "targeted" audience for advertisers. Reilly in at least Column 1 lines 13-15 discloses the use of advertising revenue to pay for information dissemination in domains such as television and radio and still in at least Column 1, lines 35-36 further discloses the use of mixing advertisements with information dissemination in newspapers and magazines to reduce the cost of the publication. Reilly, in at least Column 2, lines 24-26 and Figure 10 still further discloses an invention that mixes advertising and information content dissemination to subscribers in a manner unlike the previous examples. Therefore, it would be obvious, at the time of the invention, to a person of ordinary skill in the art to conclude that Reilly's invention is functionally equivalent to applicant's invention regarding the cost of printing being offset by advertisement revenue.

Art Unit: 3627

**Claims 392, 400, and 408:**

With regard to the further limitations:

- ***Receiving user selected output via a network.***
- ***Outputting user selected output via a print out.***

Reilly in at least Figure 1, Column 4, lines 22-31 discloses an information server coupled via a news wire interface to news feed sources such as AP, DOW and various sport information feeds. Reilly, in at least Column 4, lines 31-65 further discloses an information editor used to edit the information feeds and assigning them to categories and subcategories, from which the subscriber will select those of interest. Reilly does not disclose the printing of the displayed information provided to the subscriber. However, Reilly in at least Figure 10 discloses the information displayed to a subscriber with a Print button. Therefore, it would be obvious, at the time of the invention, to a person of ordinary skill in the art to determine that Reilly provides the user with selected content and a means for printing out that content and is similar in function to Applicant's invention.

**Claims 409, 412, and 415:**

With regard to the limitations:

- ***Receiving advertisements via a network.***
- ***Storing the advertisements in a database.***
- ***Providing a means for printing out the user selected output and advertisements.***

Reilly in at least Column 4, lines 66-67 and Column 5, lines 1-7 discloses advertisements being displayed on subscribers' workstation simultaneously with user selected news items. Reilly in at least Column 5, lines 24-33 further discloses an information database used to store news items, advertisement and display scripts. Reilly does not disclose the printing of the displayed information provided to the subscriber. However, Reilly in at least Figure 10 discloses the information displayed to a subscriber with a Print button. Therefore, it would be obvious, at the time of the invention, to a person of ordinary skill in the art to determine that Reilly provides the

user with selected content, and advertisements stored in a database and provides a means for printing out that content and the associated advertisements and is therefore similar in function to Applicant's invention.

**Claims 411, 414, and 417:**

With regard to the limitations:

- ***Advertisement information has a print effective date.***
- ***Advertisement information has a position within the printout.***

Reilly in at least Figure 4 and Column 8, lines 5-9 discloses timestamps used to indicate the time of the last update to the subscribers' news stories, and advertisements. Reilly in at least Figure 10 and Column 13, lines discloses that a portion of the data viewer screen is always occupied by an advertisement image and in at least Column 5, lines 24-33 further discloses a display script controlling number and position of the news items and advertisements. Therefore, it would be obvious, at the time of the invention, to a person of ordinary skill in the art to conclude that Reilly's invention is substantially similar to applicant's invention.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
  - DeBry, US 6,385,728 B1, teaches an on-demand printing via a network interface.
  - Skala, US 4,532,554, teaches a Facsimile Publishing System.
  - Johari et al., US 5,911,146 teaches an automatic page layout system.
  
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Danneman whose telephone number is 571-270-1863. The examiner can normally be reached on Mon.-Thurs. 6AM-5PM Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

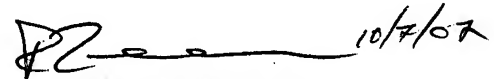


Paul Danneman

Patent Examiner

GAU 3627

8 October 2007



F. RYAN ZEENDER  
SUPERVISORY PATENT EXAMINER